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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,335	11/06/2003	James W. Scott	5490-000366	7916
27572	7590	08/24/2007		
HARNESSE, DICKEY & PIERCE, P.L.C.			EXAMINER	
P.O. BOX 828			SWIGER III, JAMES L	
BLOOMFIELD HILLS, MI 48303			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			08/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/702,335

Applicant(s)

SCOTT ET AL.

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12, 14-19 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 14-19 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/6/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 27-28, and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (US Patent 5,683,469). Johnson et al. disclose an apparatus for tibial preparation for surgery having a tibial base (11) that has a center axis (approx 42), a handle coupled to the base (14) at an anterior location (30) that is considered at least offset to a center axis considered at 42. The base is selected from the group listed in claim 2, where it may be considered a template, and wherein the handle is removably coupled to the base (where it connects with pins 34, that may also be considered a 'link'). The apparatus may be considered offset in a medial direction (compare figs 1 and 2) and wherein the handle has a longitudinal axis aligned with the center axis.

Claims 8-12, 14, 16 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (US Patent 6,159,216). Burkinshaw et al. disclose an apparatus for preparing the tibia having a base that may be reversed (12, and see also Fig. 2), a link 32 coupled to the base at 28 and is integral with the handle, which is aligned with a central axis. When connected, the link may be considered integral to the base. The link also has at least a curved portion (proximate to 18 in Fig. 1) that may be

considered relatively between the handle (26) and base (12). Also, the base of the handle portion (to the right of 26 in Fig. 1) has a cut-out portion that is considered medially offset to the central axis. It is considered curved.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. '469. Johnson et al. disclose the claimed invention except for the tibial base being specifically offset. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a base with a reversible offset, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burkinshaw et al. (US Patent 6,159,216). Burkinshaw et al. disclose the claimed invention except for specific angle ranges from 15 to 45 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the angle of the apparatus to the above dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105

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USPQ 233.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burkinshaw et al. '216 in view of Johnson et al. '469 in view of Burkinshaw et al. disclose the claimed device except for a handle that is substantially parallel to the center axis of the tibial base, and wherein the cutout portion is located with respect to this orientation. Johnson et al. disclose a handle portion that may be adjusted and substantially aligned with a center axis of the tibial base. The location of the center axis that requires substantial parallel alignment depends on where it is drawn/considered in the prosthesis, and where it is considered. Johnson et al. discloses that this adjustment helps to better fit the apparatus in sizing of the tibia (Col. 6, lines 30-39). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Burkinshaw et al. having at least the appropriately-located central axis of Johnson et al. to better adjust and use the device.

### ***Response to Arguments***

Applicant's arguments filed 6/4/2007 have been fully considered but they are not persuasive. With regards to the amendments of claim 1 directed to a longitudinal axis coaxially aligned, it is noted that the handle itself still inherently has its own longitudinal axis, and further where the axis of the tibial base is considered is relative. What is anterior to the base depends on how one looks at the base itself. The handle is still considered coupled "only" at a location as required, and being "relatively offset" is still considered to be anticipated by the prior art--essentially depending on the relative center axis. As far as the link, the prior art discloses a segment that connects two

portions that has two ends, deconstructed or not. The end portion between 34 and 38 could be considered a handle at a second end. Regarding the curved portions, as noted above, where the curved portions lie depend on their relation to the axis. The axis' location (the central or longitudinal) affects then where the lateral clearance extends, so at an "angle" it could extend in a direction as required by the claim language, and met by the prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-

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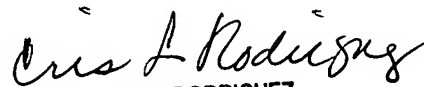
5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 8/18/2007

JLS

  
CRIS RODRIGUEZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700